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| 10/566,267      | 01/30/2006  | Yusuke Sakata        | 65836.00006         | 1678             |

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SQUIRE, SANDERS & DEMPSEY L.L.P.  
8000 TOWERS CRESCENT DRIVE  
14TH FLOOR  
VIENNA, VA 22182-6212

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| EXAMINER |
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KRUSE, DAVID H

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| ART UNIT | PAPER NUMBER |
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1638

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12/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/566,267 | <b>Applicant(s)</b><br>SAKATA ET AL. |  |
|                              | <b>Examiner</b><br>David H. Kruse    | <b>Art Unit</b><br>1638              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/14/08&amp;10/8/08</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

### **STATUS OF THE APPLICATION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. This Office action is in response to the Amendment and Remarks filed 14 August 2008.
3. Those Objections or Rejections not specifically addressed in this Office action are withdrawn in view of Applicants' amendments.
4. The rejection of claims 16-19 under 35 U.S.C. § 112, second paragraph related to the limitation "heat resistant" is withdrawn in view of Applicants' remarks (page 13, 2<sup>nd</sup> paragraph).

### ***Election/Restrictions***

5. Claims 1-9 remain withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 11 February 2008.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

### ***Information Disclosure Statement***

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7. The Information Disclosure Statements filed 8 October 2008 and 14 August 2008 have been considered, a signed copy is attached hereto.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 remains rejected and claims 10-12 and 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee (U.S. Patent Plant 10,438) in view of Pryor (1973, Quarterly Bulletin of the American Rhododendron Society vol. 27 No. 4 pages 212-214) and in further view of Teruo Tamura, et al. (April 1989, "Hirado Tsutsuji no Saibai to Yurai", Kurume no Tsutsuji, Ashi Shobo, pages 153-162 (pages 157-158 in English)). This rejection has been modified from that of record in the Office action mailed 23 May 2008 based on Applicants' amendments. Applicants' arguments filed 14 August 2008 have been fully considered but are not found persuasive.

Lee teaches a method of making a ever-flowering, heat resistant, evergreen azalea by crossing the *Rhododendron oldhamii* variety 'Fourth of July' as the male parent with an evergreen, non ever-flowering (one season flowering) azalea, variety 'Double Beauty' as the female parent to introduce into the one season flowering azalea a gene concerning ever-flowering property (see columns 2-3). Lee also teaches a novel azalea produced by the method; variety 'Conlea' which is evergreen, ever-flowering and heat resistant (see the Classification starting at column 3). The Examiner interprets the

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ability to grow well in the Independence, Louisiana region of the United States as meeting Applicants' definition of "heat resistant". Lee teaches that variety 'Fourth of July' is a perpetual bloomer and less hardy at zone 8 than at zone 7 (column 3, 3rd paragraph). Hence, it appears that the variety 'Fourth of July' is a less heat resistant azalea. The azaleas used by Lee had red flowers, a color that would have been produced by the presence of pelargonidin (an orange/red pigment), cyaniding (a red/orange pigment) and/or delphinidin (a blue pigment in a basic environment or a red pigment in an acidic environment). The examiner notes that azaleas are typically grown in acidic soils.

Lee does not teach a method of breeding azaleas by crossing an everflowering, evergreen azalea with a deciduous, one season flowering azalea (see Applicants' arguments on page 16, 2<sup>nd</sup> paragraph) using a Hirado azalea or a Hirado Azalea Hybrid.

Pryor teaches crossing evergreen azaleas with deciduous azaleas, and that progeny produced there from comprise evergreen characteristics. Pryor further teaches stabilization of the evergreen characteristic by backcrossing the F1 hybrid to produce evergreen F2 progeny (see entire document, in particular Table 1).

Teruo Tamura *et al* teach that Hirado azaleas had been used in the breeding of azaleas (page 157, 2<sup>nd</sup> paragraph).

It would have been *prima face* obvious to one of ordinary skill in the art at the time of Applicants' invention that one could modify the teachings of Lee to use the azalea variety 'Fourth of July' to introduce into a one season flowering azalea a gene concerning ever-flowering property such as a Hirado azalea (as stated in the previous

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Office action). It would have also been obvious to one of ordinary skill in the art to modify the teachings of Lee to use the azalea variety 'Fourth of July' to introduce into a deciduous, one season flowering azalea a gene concerning ever-flowering property. The selection of flower color of the parents of such a cross would be considered a design choice by the azalea breeder (see for example Pryor, who was attempting to introduce a yellow flower color into an evergreen azalea progeny). The selection of a specific type of azalea to use in a breeding method would have been a design choice based on obvious characteristics such as growth habit and flower characteristics, in addition to the ever-flowering property taught by Lee.

Applicants argue that Lee is directed to an evergreen azalea of the genus *Rhododendron* and a member of the Ericaceae family. Applicants argue that the new azalea is referred to as 'Conlea,' which was discovered by Robert Edward Lee in October 1985 in Independence, La. 'Conlea' originated from a planned cross hybridization between two selected breeding lines in a controlled breeding program in Independence, La. Applicants argue that the value of this new cultivar lies in its unique blooming period, bloom color, bloom form, and growth habit (Lee, Background of the Invention). Applicants argue that Lee fails to disclose or suggest every feature recited in claim 10. Applicants argue that in particular, Lee fails to disclose or suggest, at least, "introducing a genotype from an azalea comprising an ever-flowering property into a deciduous, one season flowering azalea to breed an ever-flowering azalea," as recited in claim 10 (emphasis added). Applicants argue that Lee discloses a planned cross hybridization between two selected breeding lines in a controlled breeding program.

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Applicants argue that the female, or seed parent, of 'Conlea' is the Azalea 'Double Beauty' which is a recognized evergreen, one-season flowering azalea. Applicants argue that the male, or pollen parent, is *Rhododendron oldhamii* 'Fourth of July' which is an evergreen, ever-flowering azalea (Lee, columns 1-3). Applicants argue that Lee fails to disclose or suggest that the one season flowering azalea is deciduous.

Applicants argue that accordingly, Lee fails to disclose or suggest every feature recited in claim 10 (pages 15-16 of the Remarks). These arguments are not found to be persuasive, and have been addressed above.

Applicants argue that Tamura fails to disclose or suggest, at least, "introducing a genotype comprising an ever- flowering property into a deciduous one season flowering azalea to breed an ever- flowering azalea," as recited in claim 10 (emphasis added) (page 17, 3<sup>rd</sup> paragraph of the Remarks). Applicants argue that it is improper to base a rejection of the claimed features being merely a design choice. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically stated: "the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none (page 17, 5<sup>th</sup> paragraph of the Remarks). These arguments are not found to be persuasive. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that

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instance the fact that a combination was obvious to try might show that it was obvious under §103." See *KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL* (82 USPQ2d at 1397).

Applicants argue that The Board further states that "the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351,353 (Bd. Pat. App. & Inter. 1984) (See MPEP §2144.04(IV)(C)) (page 18, 1<sup>st</sup> paragraph of the Remarks). This argument is not found to be persuasive. KSR forecloses the argument that a **specific** teaching, suggestion or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

Applicants argue that the teachings of Lee specifically disclose that Lee purposely planned a cross hybridization between two selected breeding lines in a controlled breeding program in Independence, La. Applicants argue that the value of this new cultivar lies in its unique blooming period, bloom color, bloom form, and growth habit (Lee, Background of the Invention). Applicants argue that Lee purposely chose the Azalea 'Double Beauty' and the *Rhododendron oldhamii* 'Fourth of July' for his planned cross hybridization; and therefore, the teachings of Lee and the teachings of Tamura provide no motivation to substitute the Azalea 'Double Beauty' with a Hiroda



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azalea. Applicants argue that The Office Action failed to provide a proper motivation that would have motivated one of ordinary skill in the art to modify the teachings of Lee with the teachings of Tamura keeping with the intended purpose and teachings of Lee (page 18, 2<sup>nd</sup> paragraph of the Remarks). These arguments are not found to be persuasive.

Lee had taught that it was obvious to one of ordinary skill in the art to introduce desired traits of the 'Fourth of July' azalea into other azalea plants, especially the ever-flowering property.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. No claims are allowed.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is **(571) 272-0799**. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at **(571) 272-0975**. The **central FAX number for official correspondence** is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

/David H Kruse/  
Primary Examiner, Art Unit 1638  
4 December 2008